

6-22-04

AK1731  
IFW

Date: June 21, 2004 Label No. EV369584830US

I hereby certify that, on the date indicated above, I deposited this paper with the U.S. Postal Service and that it was addressed for delivery to the Commissioner For Patents, P.O. Box 1450. Alexandria, VA 22313-1450 by "Express Mail Post Office to Addressee" service.

Donald S. Prater  
Name (Print)

*Donald S. Prater*  
Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: HILL et al.	)	Examiner: Marc S. Alvo
	)	
Application No.: 09/711,126	)	Group Art Unit: 1731
	)	
Filed: November 13, 2000	)	Confirmation No.: 6456
	)	
Docket No.: 3597-112-01	)	Customer No.: 33432
For: PAPER MAKING PROCESSES USING ENZYME AND POLYMER COMBINATIONS		

**REPLY TO EXAMINER'S ANSWER**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

June 21, 2004

Sir:

This Reply is in response to the Examiner's Answer dated April 21, 2004. This Reply (in triplicate) is being submitted within two (2) months of the date of the Examiner's Answer and therefore is timely. The Board of Patent Appeals and Interferences is respectfully requested to consider the following comments that are in direct response to the Examiner's Answer.

The Examiner's comments in response to the Brief on Appeal necessitate several comments by the appellants.

1.) In particular, the Examiner fails to acknowledge that claim 13 stands or falls on its own and that claim 18 stands or falls on its own.

The appellants, in the Appellants' Brief on Appeal, at page 4, section VII, specifically state that claim 13 stands or falls on its own, and claim 18 stands or falls on its own. Furthermore, the Appellants' Brief on Appeal, at pages 13 and 14, provides the reasons why claims 13 and 18 are separately patentable.

2.) With respect to the Examiner's section (6), at page 2 of the Examiner's Answer,

the Examiner's reference to the rejection under 35 U.S.C. § 112 is not understood. There was no § 112 rejection in the final Office Action and the particular terms pointed out by the Examiner were not in the claims as pending in the final Office Action. Accordingly, it appears that the statements made by the Examiner are in error.

3.) Throughout the Examiner's Answer, the Examiner used the argument that the cited art, namely Sarkar et al. '497 reads on the phrase "about the same time." However, as stated in the Brief on Appeal, the Examiner's arguments are misdirected. Claim 1 and the claims dependent thereon clearly recite a time of "within 5 minutes of each other." The Examiner appears to be using language from the specification or language that was in previous earlier versions of the claim. However, the claims on appeal clearly recite a time unit of within 5 minutes. Thus, the Examiner's arguments relating to the phrase "about the same time" must be discounted since the Examiner is not considering the language in the claims on appeal.

Furthermore, the Examiner asserts that the time recited in the claims has not been compared to the 10 minutes of Sarkar et al. '497. However, the appellants disagree as set forth in the Brief on Appeal. The data in Sarkar et al. '497 clearly shows why one would not go even below 20 minutes in Sarkar et al. since Sarkar et al. '497 provides data showing poor property performance when one goes below 20 minutes. Thus, Sarkar et al. '497 teaches away from the claimed invention and therefore no further data needs to be provided by anyone. The Examiner simply has not set forth a *prima facie* case of obviousness. The Examiner merely argues that it would be obvious to use shorter times but cannot point to a single disclosure in Sarkar et al. '497 or Sarkar et al. '914 to teach or suggest a shorter time. The Examiner can only argue that the 10 minute test in Sarkar et al., which was considered to be a poor performance compared to the 20 minute test set forth in Sarkar et al. '497, would somehow teach or suggest even lower times. However, this is a clear example of the Examiner taking an obvious-to-try standard as well as an

effort on the part of the Examiner to improperly use hindsight, especially by looking at the specification of the present application to somehow argue that Sarkar et al. '497 suggests times less than 10 minutes. This clearly is not a proper ground for rejection.

4.) With respect to page 8 of the Examiner's Answer and the argument by the Examiner that with respect to claim 31 on appeal, the arguments are not convincing since the claim does not claim that the steps occur sequentially. The Examiner argues that the claim reads on either component being introduced before the other. However, unfortunately, the Examiner did not carefully read claim 31.

Claim 31 clearly states that in step a), the cationic polymer composition is introduced to a pulp "to form treated pulp." Thus, the treated pulp is defined as a pulp that also contains the cationic polymer composition. Step b) of claim 31 then recites that at least one cellulytic enzyme composition is introduced "to said treated pulp to form an enzyme-treated pulp." Clearly, step b) indicates that the cellulytic enzyme composition is introduced to the treated pulp, which as stated above and as stated in claim 31, refers to a pulp that contains pulp and the cationic polymer composition. Thus, claim 31 clearly and literally states that the enzyme is introduced to a pulp that already contains the cationic polymer composition. Lastly, step c) recites that a nitrogen-containing cationic polymer composition is added to the enzyme-treated pulp. As indicated in step b), the enzyme-treated pulp must contain the cellulytic enzyme composition and the cationic polymer composition along with the pulp. These terms are clearly set forth in claim 31 and under the United States Patent Laws have meaning. Thus, the Examiner's comments regarding claim 31 and its interpretation are clearly wrong. The Examiner is misreading the claim and ignoring the limitations as clearly set forth in claim 31.

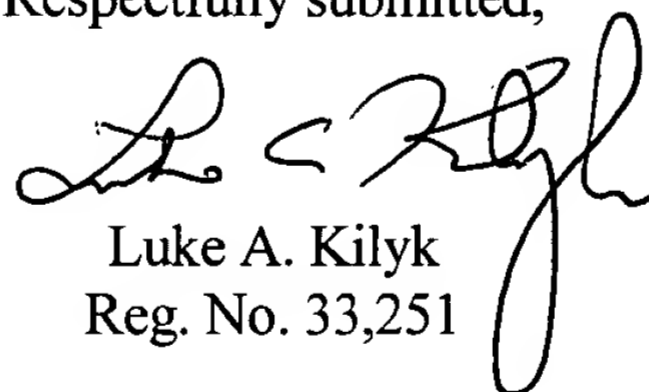
5.) With respect to the Examiner's comments at page 7 of the Examiner's Answer regarding criticality, criticality is not a standard for determining patentability of a claim. The

subject matter of the claim must be taught or suggested in the prior art and that teaching or suggestion must be found in the cited art. While the Examiner argues that the use of starch is well known in the art, the Examiner chooses to ignore the order of addition and simply argues that criticality must be shown for the order of addition. However, the Examiner has not shown a single piece of prior art which shows the order of addition as set forth in the claimed invention. Absent such a teaching or even a suggestion, the claims are patentable over the cited art. After all, if the prior art has gone through the trouble of specifying a particular order, and in many cases, even claims that precise order, it is clear the prior art is only teaching such an order. The Examiner cannot simply ignore this teaching in a reference and use hindsight to argue that the claimed invention is obvious.

Accordingly, for the reasons set forth in the Brief on Appeal filed on February 9, 2004 and additionally for the reasons set forth herein, it is respectfully submitted that the Examiner's rejections of the pending claims are in error and should be reversed.

If there are any additional fees due in connection with the filing of this Reply to Examiner's Answer, please charge the fee to Deposit Account No. 50-0925.

Respectfully submitted,



Luke A. Kilyk  
Reg. No. 33,251

Atty. Docket No. 3597-112-01  
KILYK & BOWERSOX, P.L.L.C.  
53A East Lee Street  
Warrenton, VA 20186  
Tel.: (540) 428-1701  
Fax: (540) 428-1721